

Remark

Applicant respectfully requests reconsideration of this application. Three claims have been amended. No claims have been cancelled. Therefore, claims 1-6 are present for examination.

35 U.S.C. §103 Rejection

The Examiner has rejected claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Dinwoodie, W/O 99/63461 (hereinafter "Dinwoodie"), in view of Fisher, et al., U.S. Patent No. 5,835,896 (hereinafter "Fisher"). It is noted that the Examiner referred to the Dinwoodie application as the "Korn" application in his office action. It is assumed that this designation was in error as Korn was merely the agent of the inventor Dinwoodie.

Dinwoodie is Not a Valid Reference Against the Application

It is called to the attention of the Examiner that Dinwoodie is a published international application that was published after the filing date of the patent application thereby removing it as a section 102(a) reference, and the Dinwoodie reference has, of date, not resulted in a patent thereby removing it as a section 102(e) reference.

It is noted that the new subsection 102(e) that took effect on November 29, 1999, as part of the American Inventor's Protection Act (AIPA) DOES NOT apply to either the Dinwoodie reference or the application. The Examiner is encouraged to reference Section 4508 of the AIPA, which is available on the USPTO website. Section 4508 discusses the effective date of the new 102(e) subsection. A copy of the pertinent

sections are attached for the Examiner. In short, the new 102(e) subsection applies only to applications filed after November 29, 2000. Dinwoodie was filed on December 8, 1999.

Since any art utilized under section 103 must qualify as prior art under one of the 102 subsections, Dinwoodie is not a section 103 valid reference. Accordingly, the Examiner has failed to present a valid prima facie case of obviousness.

Claim 1 and Dependent Claims 2 and 3

Fisher, the only legally valid reference presented by the Examiner, fails to teach or suggest all the limitations of claim 1, including the limitations relating to a **live, in-person auction**. In particular, Fisher fails to disclose or teach both “updating bidding information associated with an item in a online environment to reflect a current bid associated with the item in a **live, in-person auction**” and “bidding on behalf of the online bidder against one or more live bidders that are participating in **the live, in-person auction** based upon the maximum proxy price.”

A live, in-person auction as described in the specification and as understood by one of ordinary skill in the art is one in which one or more bidders are gathered together in essentially the same place to buy and sell one or more items or services. Random House Webster’s Unabridged Dictionary defines “in person” as:

in one's own bodily presence; personally: *Applicants are requested to apply in person*

(i.e., the one or more bidders are in the presence of each other). In contrast, figure 1 and the accompanying description in Fisher teach a number of remote terminals through which potential customers access the host computer that is running the auction. *See col.*

7, lines 24-30.

For at least the reasons given above, claim 1 and dependent claims 2 and 3 are distinguished over the relied-upon art. Accordingly, claims 1-3 are in a condition of allowance over the relied-upon art.

Claims 4, 5 and 6

Each of the independent claims 4-6 require that a portion of the auction be conducted live. As discussed *supra*, the Fisher reference does not teach or suggest the use of a live auction to sell goods and services. Therefore, for at least the reasons given above, claims 4-6 are distinguished over the relied-upon art and are in a condition for allowance.

Because the undersigned has clearly and definitively distinguished over the relied-upon art, the Examiner is not permitted to issue a final office action in this case as per MPEP 706.07(a). The Examiner may either allow the claims or present new rejections based on newly relied-upon art.

Conclusion

The undersigned respectfully submits that the rejections have been overcome, and that the claims are in condition for allowance. Accordingly, the Undersigned respectfully requests the rejections be withdrawn and the claims be allowed.

Invitation for a Telephone Interview

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

Request for an Extension of Time

The Applicant respectfully petitions for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 12/21/00



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Attachment A

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1 shall not apply to provisional rights under section
2 154(d) of this title.”.

3 (10) Section 374 is amended to read as follows:

4 **“§ 374. Publication of international application**

5 “The publication under the treaty defined in section
6 351(a) of this title, of an international application desig-
7 nating the United States shall confer the same rights and
8 shall have the same effect under this title as an application
9 for patent published under section 122(b), except as pro-
10 vided in sections 102(e) and 154(d) of this title.”.

11 (11) Section 135(b) is amended—

12 (A) by inserting “(1)” after “(b)”; and

13 (B) by adding at the end the following:

14 “(2) A claim which is the same as, or for the same
15 or substantially the same subject matter as, a claim of
16 an application published under section 122(b) of this title
17 may be made in an application filed after the application
18 is published only if the claim is made before 1 year after
19 the date on which the application is published.”.

20 **SEC. 4508. EFFECTIVE DATE.**

21 Sections 4502 through 4507, and the amendments
22 made by such sections, shall take effect on the date that
23 is 1 year after the date of the enactment of this Act and
24 shall apply to all applications filed under section 111 of
25 title 35, United States Code, on or after that date, and]

1 all applications complying with section 371 of title 35,
2 United States Code, that resulted from international ap-
3 plications filed on or after that date. The amendments
4 made by sections 4504 and 4505 shall apply to any such
5 application voluntarily published by the applicant under
6 procedures established under this subtitle that is pending
7 on the date that is 1 year after the date of the enactment
8 of this Act. The amendment made by section 4504 shall
9 also apply to international applications designating the
10 United States that are filed on or after the date that is
11 1 year after the date of the enactment of this Act.

12 **Subtitle F—Optional Inter Partes**

13 **Reexamination Procedure**

14 **SEC. 4601. SHORT TITLE.**

15 This subtitle may be cited as the “Optional Inter
16 Partes Reexamination Procedure Act of 1999”.

17 **SEC. 4602. EX PARTE REEXAMINATION OF PATENTS.**

18 The chapter heading for chapter 30 of title 35,
19 United States Code, is amended by inserting “**EX**
20 **PARTE**” before “**REEXAMINATION OF PAT-**
21 **ENTS**”.

22 **SEC. 4603. DEFINITIONS.**

23 Section 100 of title 35, United States Code, is
24 amended by adding at the end the following new sub-
25 section:

1 “(4) REQUIREMENTS FOR INTERNATIONAL AP-
2 PLICATIONS.—

3 “(A) EFFECTIVE DATE.—The right under
4 paragraph (1) to obtain a reasonable royalty
5 based upon the publication under the treaty de-
6 fined in section 351(a) of an international ap-
7 plication designating the United States shall
8 commence on the date on which the Patent and
9 Trademark Office receives a copy of the publi-
10 cation under the treaty of the international ap-
11 plication, or, if the publication under the treaty
12 of the international application is in a language
13 other than English, on the date on which the
14 Patent and Trademark Office receives a trans-
15 lation of the international application in the
16 English language.

17 “(B) COPIES.—The Director may require
18 the applicant to provide a copy of the inter-
19 national application and a translation thereof.”.

20 **SEC. 4505. PRIOR ART EFFECT OF PUBLISHED APPLICA-**
21 **TIONS.**

22 Section 102(e) of title 35, United States Code, is
23 amended to read as follows:

24 “(e) The invention was described in—

1 “(1) an application for patent, published under
2 section 122(b), by another filed in the United States
3 before the invention by the applicant for patent, ex-
4 cept that an international application filed under the
5 treaty defined in section 351(a) shall have the effect
6 under this subsection of a national application pub-
7 lished under section 122(b) only if the international
8 application designating the United States was pub-
9 lished under Article 21(2)(a) of such treaty in the
10 English language; or

11 “(2) a patent granted on an application for pat-
12 ent by another filed in the United States before the
13 invention by the applicant for patent, except that a
14 patent shall not be deemed filed in the United States
15 for the purposes of this subsection based on the fil-
16 ing of an international application filed under the
17 treaty defined in section 351(a); or”

18 **SEC. 4506. COST RECOVERY FOR PUBLICATION.**

19 The Under Secretary of Commerce for Intellectual
20 Property and Director of the United States Patent and
21 Trademark Office shall recover the cost of early publica-
22 tion required by the amendment made by section 4502 by
23 charging a separate publication fee after notice of allow-
24 ance is given under section 151 of title 35, United States
25 Code.